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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
10/667,248	09/17/2003	Michael Adam	51082/TJD/M881	1126	
57715	7590	06/22/2007	EXAMINER		
CHRISTIE, PARKER & HALE, LLP			HOFFMAN, MARY C		
P.O. BOX 7068			ART UNIT	PAPER NUMBER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/667,248	ADAM, MICHAEL
	Examiner Mary Hoffman	Art Unit 3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 27 March 2007.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-9 and 11-28 is/are pending in the application.  
 4a) Of the above claim(s) 2-9, 18-20, 23, 24 and 26-28 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1, 11-17, 21, 22 and 25 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### *Election/Restrictions*

Claims 2-9, 18-20, 23-24 and 26-28 are currently withdrawn (see previous office actions mailed 10/06/2005 and 02/23/2006). This includes newly added claim 28, which depends from previously withdrawn claim 3.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,11,13,15-17, 22 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Wahl et al. (U.S. Patent No. 6,228,086).

Wahl et al. disclose a bone fixing system comprising a nail (ref. #1 and 7), the nail comprising a longitudinal axis, a longitudinal bore defining an inner wall of the nail, and three transverse bores and three screws (see holes and corresponding screws ref. #18, ref. #29, col. 4, lines 4-5), which can be guided through the transverse bores formed in the nail the transverse bores being configured so as to define an orientation and a position of a screw with respect to the longitudinal axis of the nail in three dimensions, wherein the spatial orientation and position imposed on a screw guided through one of the transverse bores is different for each of the three transverse bores

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The bone fixing system further comprises at least one clamping member (ref. #21) which can be introduced into the longitudinal bore and is axially adjustable in the longitudinal bore relative to the nail, with all screws guided through the transverse bores being able to be clamped between a clamping member and the inner wall of the nail bounding the transverse bore by a displacement of the clamping member. The system further comprises a displacement device (tool inserted into hex bores of ref. #21) arranged and adapted for effecting a pulling force on a clamping member, wherein a section of the clamping member disposed on a side of a screw remote from the displacement device can be moved against the screw by the pulling force. The displacement device includes a drawing screw (ref. #24) which cooperates with a thread section of the clamping member and is supported at the nail so as to pull the clamping member in the axial direction when actuated. The clamping member is adapted to be deformed in the axial direction by means of the displacement device. The system comprises a plurality of screws, wherein the clamping member can be deformed such that the plurality of screws spaced apart from one another in the axial direction of the nail can each be clamped between the clamping member and the inner wall of the nail bounding the respective transverse bore by the displacement of the clamping member. The system comprises a securing member (ref. #9) which can be moved through a side wall of the nail into the longitudinal bore and by which the clamping member can be fixed in a starting position relative to the nail prior to the actuation of the displacement device. The transverse bores are essentially circular in cross section. The longitudinal bore is capable of receiving a bushing-like or sleeve-like member.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wahl et al. (U.S. Patent No. 6,228,086) in view of Stauch et al (U.S. Patent No. 6,416,516).

Wahl et al. teaches the claimed invention except for a securing member (pin, ref. #9) being a threaded screw.

Stauch discloses using a threaded pin (see FIG. 2a) as a securing member which passes radially through the side wall of the nail in order to secure and clamp the insert, providing a means of securing against removal during operation and to prevent axial movement of the insert (ref. #6, col. 3, lines 25-42).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to construct the device of Wahl et al. using a threaded pin as a securing member in view of Stauch in order to secure and clamp the inside clamping device, providing a means of securing against removal during operation and to prevent axial movement of the clamping member.

Claims 1, 11-17 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeland (U.S. Patent No. 4,862,833)

Freeland disclose a bone fixing system comprising a nail (ref. #R), the nail comprising a longitudinal axis, a longitudinal bore defining an inner wall of the nail, and one transverse bore and one screw (ref. #55,56, and ref. #S), which can be guided through the transverse bore formed in the nail the transverse bores being configured so as to define an orientation and a position of a screw with respect to the longitudinal axis of the nail. The bone fixing system further comprises at least one clamping member (ref. #I) which can be introduced into the longitudinal bore and is axially adjustable in the longitudinal bore relative to the nail, with the screws being guided through the transverse bore being able to be clamped between a clamping member and the inner

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wall of the nail bounding the transverse bore by a displacement of at least one clamping member. The system further comprises a displacement device (ref. #72) arranged and adapted for effecting a pulling force on a clamping member, wherein a section of the clamping member disposed on a side of a screw remote from the displacement device can be moved against the screw by the pulling force. The displacement device includes a drawing screw (ref. #72) which cooperates with a thread sectioned of the clamping member and is supported at the nail so as to pull the clamping member in the axial direction when actuated. The clamping member is adapted to be deformed in the axial direction by means of the displacement device. The clamping member can be deformed such that the screws can be clamped between the clamping member and the inner wall of the nail bounding the respective transverse bore by the displacement of the clamping member. The transverse bore is essentially circular in cross section. The longitudinal bore being capable of receiving a bushing-like or sleeve-like member.

Freeland discloses the claimed invention except for there being three transverse bores, three screws, the screws imposable at different spatial orientation and positions in three dimensions.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the assembly of Freeland having a plurality of transverse bores and screws (e.g. three) imposable at different spatial orientations/positions in three dimensions, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

***Response to Arguments***

Applicant's arguments filed 03/27/2007 have been fully considered but they are not persuasive.

Applicant argues that the prior art does not show "the spatial orientation and position imposed on a screw guided through one of the transverse bores is different in three dimensions for each of three transverse bores...". the examiner respectfully disagrees. The Wahl et al. reference discloses three transverse bores and three screws (see holes and bores, ref. #18, ref. #29, col. 4, lines 4-5). Inherently, these three bores will be located at different locations along member ref. #7. While the bores are not shown at varying angles relative the longitudinal axis as shown in Applicant's invention, it is noted that Applicant is not claiming this feature. Rather, Applicant is merely claiming that the bores are located at different orientations/positions in three dimensions. Currently, the screws and bores of Wahl et al., which occupy different places in a three-dimensional space, anticipate the claims. Similarly, the screws and bores of Freeland reference 35 U.S. C. 103(a) rejection anticipate the claims, since the transverse bores and screws will occupy different spatial position/orientations in three-dimensions.

Applicant also argues that the Wahl et al. reference does not show a nail comprising three bores. The examiner respectfully disagrees, since it was clearly stated in the Non-final rejection mailed 10/26/2007 that the combination of ref. #1 and ref. #7

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(ref. #7 comprises the three bores) is being considered the "nail". The examiner asserts that this is a reasonable interpretation of the reference.

The rejections are deemed proper.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

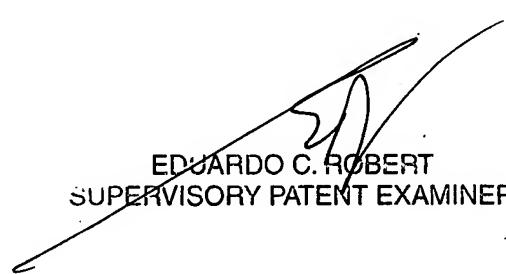
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Hoffman whose telephone number is 571-272-5566. The examiner can normally be reached on Monday-Friday 9:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo C. Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MCH

  
EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER